

# Notice of Allowability

Application No.

09/937,187

Examiner

Jeff Lundgren

Applicant(s)

SANDMAN ET AL.

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to July 18, 2006.
2. ☒ The allowed claim(s) is/are 59 and 61-75.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All b) ☐ Some\* c) ☐ None of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☒ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

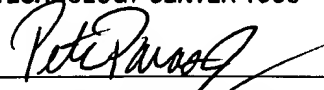
Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

PETER PARAS, JR.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600



## **DETAILED ACTION**

### ***Request for Continued Examination Under 37 CFR § 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2006, has been entered.

Claims 59 and 61-75 are pending in the instant application; claims 65-75, which were previously withdrawn, are rejoined with claims 59 and 61-64, and are the subject of the Office Action below.

### ***Withdrawn Claim Rejections***

The rejection of the claims under 35 U.S.C. § 112, first paragraph for lack of written description is withdrawn in view of Applicants' amendment to the claims.

The rejection of the claims under 35 U.S.C. §§ 102(a) and/or (b) as being unpatentable in view of Sandman *et al.*, is withdrawn for the reasons argued by Applicants.

The rejection of the claims under 35 U.S.C. §§ 102(a), (b) and/or (e) as being unpatentable in view of Larsen *et al.*, or in the alternative, under 35 U.S.C. § 103(a) in view of Hollinger *et al.*, is withdrawn for the reasons argued by Applicants.

### ***Examiner's Amendment to the Claims***

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Dr. Harriet Strimple on July 24, 2006.

Art Unit: 1639

The application has been amended as follows:

In claim 74, insert the term “single” in place of the term “native.”

***Declaration Under 37 C.F.R. § 1.132***

The Declaration submitted by Dr. Christopher J. Noren has been considered and is proper. Regarding the publication of an abstract relevant to the instant invention (Sandman *et al.*, *FASEB Journal*, (April 23, 1999) Vol. 13, No. 7, pp. A1479), Dr. Noren declares that author Mr. Jack Benner is not an inventor of the instantly claimed invention. Accordingly, this reference is removed as prior art under 35 U.S.C. §§ 102(a) and/or 103(a).

***Copending Application No. 10/893,744***

Previously, copending U.S. Application No. 10/893,744 contained pending claims that would not have been patently distinct from the claims in the instant application. However, a Restriction Requirement has been issued by the Office for U.S. Application No. 10/893,744 on June 1, 2006, and Applicants have elected an invention with claims directed to subject matter that is patently distinct from the instant claims in their Reply filed on July 17, 2006.

***Reasons for Allowance***

Applicants' claimed invention is free of the prior art. In particular, the closest art of record, Larsen *et al.*, does not teach or fairly suggest the incorporation of a selenocysteine residue into a phage/virus or cell-based, fusion peptide, library display system. Instead, Larsen only expresses selenocysteine-containing peptides within intracellular domains and fails to address certain essential issues disclosed by Applicants.

***Conclusions***

Claims 59 and 61-75 are allowable.

Art Unit: 1639

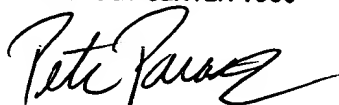
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Peter Paras, can be reached on 571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JSL

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A handwritten signature in black ink, appearing to read "Peter Paras", written in a cursive style.